

REMARKS

I. Introduction

Claims 1 and 6 to 25 are pending in the present application. In view of the foregoing amendments and the following remarks, it is respectfully submitted that the present application is in condition for allowance, and reconsideration is respectfully requested.

II. Statement of Substance of Telephone Interview

Applicants thank Examiner Regina Liang for the courtesies extended during the course of the telephone discussions of December 22, 2007 and December 23, 2007. The general thrust of the arguments made by Applicants in those discussions is that U.S. Patent No. 7,113,177 does not constitute prior art against the present application under 35 U.S.C. § 102(e), for the reasons set forth in the “Reply Under 37 C.F.R. § 1.116” filed on September 20, 2007. The general outcome of those discussions is that these arguments were agree to and that Office Action issued on November 27, 2007 would be withdrawn.

III. Rejection of Claims 7, 8, and 10 Under 35 U.S.C. § 112, First Paragraph

Claims 7, 8, and 10 were rejected under 35 U.S.C. 112, first paragraph as allegedly failing to comply with the enablement requirement. It is respectfully submitted that the present rejection should be withdrawn for at least the following reasons.

The Office Action alleges at page 3 that “[t]he specification does not provide any description as to **how** the actuator layer is deformable as a function of an electromagnetic field or optical signal, e.g., light as claimed.” Applicant respectfully disagrees. In this regard, it is respectfully submitted that one of ordinary skill in the art at the time of invention would be able to apply known photomechanical and/or electromagnetic actuation principles in the context of the present claims without undue experimentation. It is noted that “[t]he fact that experimentation may be complex does not necessarily make it undue, if the art typically engages in such experimentation.” MPEP § 2164.01; In re Certain Limited-Charge Cell Culture Microcarriers, 221 USPQ 1165, 1174 (Int'l Trade Comm'n 1983). Moreover, “[a]

patent need not teach, and preferably omits, what is well known in the art.” MPEP § 2164.01; In re Buchner, 929 F.2d 660, 661 (Fed. Cir. 1991).

Furthermore, the Specification mentioned, for example, at page 3, lines 26 to 30, that an actuator layer may include a sol-gel. The Specification mentions “Glass Menagerie,” <http://www.siu.edu/worda/persp/f98/Glass.html> (cited in the Information Disclosure Statement filed on July 31, 2003), which describes “smart glasses,” that can change shape responsive to “heat, pressure, electric fields, pH, salt concentrations, solvents, and so forth” and that “[b]y changing one or more of these conditions, you can modify the shape of the material, then return it to its original state.” Reference is also made to U.S. Patent No. 6,756,217 (cited in the Supplemental Information Disclosure Statement filed herewith).

Furthermore, the Office Action appears to reflect a misapprehension of the enablement requirement and a misapprehension of the difference between the distinct concepts of the enablement requirement and the written description requirement. In this regard, the Office Action asserts at page 6 that “undue experimentation is required of a personal [sic] of ordinary skill in the art in order to make and or use the invention,” but it does so conclusorily. As stated, for example, in U.S. v. Teletronics, Inc., 857 F.2d 778, 785, 8 U.S.P.Q.2d 1217, 1223 (Fed. Cir. 1988), “[t]he test of enablement is whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation.” Among the factors that **must** be considered in determining whether there is sufficient evidence to support a determination that a disclosure does not satisfy the enablement requirement and whether any necessary experimentation is undue include: (a) the breadth of the claims; (b) the nature of the invention; (c) the state of the prior art; (d) the level of one of ordinary skill; (e) the level of predictability in the art; (f) the amount of direction provided by the inventor; (g) the existence of working examples; and (h) the quantity of experimentation needed to make or use the invention based on the content of the disclosure. In re Wands, 858 F.2d 731, 737, 8 U.S.P.Q.2d 1400, 1404 (Fed. Cir. 1988). It is **improper** to conclude that a disclosure is not enabling based on an analysis of only one of the above factors while ignoring one or more of the others. That is, a proper analysis must include a consideration of all the evidence related to each of these factors. None of the Office Actions to date have conducted a proper analysis.

Regarding the apparent misapprehension of the difference between the distinct concepts of the enablement requirement and the written description requirement, the Office Action states at page 6 that “the specification . . . failed to show that applicant had ***possession of the claimed subject matter***” (emphasis added). Whether a patent applicant had possession of the claimed subject matter is a question of ***written description***, not enablement.

In view of the foregoing, it is respectfully submitted that claims 7, 8, and 10 are sufficiently enabled. Accordingly, withdrawal of this rejection is respectfully requested.

IV. Rejection of Claims 1, 6 to 13, and 15 to 25 Under 35 U.S.C. § 103(a)

Claims 1, 6 to 13, and 15 to 25 were rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of PCT International Patent Application Publication No. WO 02/27645 (“Franzen”), “Hyper-Redundant Robot Manipulators Actuated by Optimized Binary Dielectric Polymers” (“Wingert et al.”), and U.S. Patent No. 6,373,472 (“Palalau et al.”). It is respectfully submitted that the combination of Franzen, Wingert et al., and Palalau et al. does not render unpatentable the present claims for at least the following reasons.

As an initial matter, it is respectfully submitted that the machine-generated translation of Franzen does not constitute prior art against the present application, since that machine-generated translation bears a date of January 9, 2008. Furthermore, the machine-generated translation is replete with apparent typographic errors and certain phrases and terms remaining untranslated. See, e.g., page 4, fifth paragraph (referring to “berührungssensi”). Accordingly, an accurate English translation of Franzen is respectfully requested, as required pursuant to M.P.E.P. § 706.02 (“If the document is in a language other than English and the examiner seeks to rely on that document, a translation ***must*** be obtained so that the record is ***clear*** as to the ***precise*** facts the examiner is relying upon in support of the rejection.” (Emphasis added)).

As amended herein without prejudice, claim 1 recites that an actuator layer is arranged on an outwardly facing side of the display. Support for this amendment may be found, for example, at Figures 3 to 5 and at page 5, lines 15 to 35 of the Specification. In addition, claims 20 to 22 have been amended herein without prejudice in analogous manner. Franzen, Wingert et al., and Palalau et al.,

alone or in combination, do not disclose, or even suggest, an actuator layer arranged on an outwardly facing side of a display. With regard to Franzen, it is noted that the piezoelectric matrix S3 is disposed beneath -- i.e., on the inwardly facing side of -- the electronic paper layer S2.

As indicated above, the combination of Franzen, Wingert et al., and Palalau et al. does not disclose, or even suggest, all of the features recited in any of claims 1 and 20 to 22. As such, it is respectfully submitted that the combination of Franzen, Wingert et al., and Palalau et al. does not render unpatentable any of claims 1 and 20 to 22.

As for claims 6 to 13, 15 to 19 and 23 to 25, which ultimately depend from claim 1 and therefore include all of the features recited in claim 1, it is respectfully submitted that the combination of Franzen, Wingert et al., and Palalau et al. does not render unpatentable these dependent claims for at least the same reasons more fully set forth above in support of the patentability of claim 1.

In view of all of the foregoing, withdrawal of this rejection is respectfully requested.

V. Rejection of Claim 14 Under 35 U.S.C. § 103(a)

Claim 14 was rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Franzen, Wingert et al., Palalau et al., and U.S. Patent Application Publication No. 2004/0017362 (“Mulligan et al.”). It is respectfully submitted that the combination of Franzen, Wingert et al., Palalau et al., and Mulligan et al. does not render unpatentable claim 14 for at least the following reasons.

Claim 14 depends from claim 1 and therefore includes all of the features recited in claim 1. As more fully set forth above, Franzen, Wingert et al., and Palalau et al., alone or in combination, do not disclose or suggest all of the features recited in claim 1. Mulligan et al. do not disclose or suggest the features of claim 1 not disclosed or suggested by the combination of Franzen, Wingert et al., and Palalau et al.

In view of the foregoing, it is respectfully submitted that the combination of Franzen, Wingert et al., Palalau et al., and Mulligan et al. does not disclose, or even suggest, all of the features of claim 14. As such, it is respectfully

submitted that the combination of Franzen, Wingert et al., Palalau et al., and Mulligan et al. does not render unpatentable claim 14.

In view of all of the foregoing, withdrawal of this rejection is respectfully submitted.

VI. Conclusion

It is therefore respectfully submitted that all of the presently pending claims are allowable. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is earnestly solicited.

Respectfully submitted,

Dated: March 4, 2008

By: /Clifford A. Ulrich/
Clifford A. Ulrich
Reg. No. 42,194

KENYON & KENYON LLP
One Broadway
New York, NY 10004
(212) 425-7200
CUSTOMER NO. 26646